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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/720,927	10/04/1996	ASHER GIL	PI/3C	2200

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LAURA G BARROW
P O BOX 215
ESTERO, FL 339280215

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/720,927

Applicant(s)

GIL ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The amendment of 5/18/05 has been entered. This action will be a non-final due to new issues that have not previously been raised or addressed in the prosecution of this application to date.

With respect to the pending claims and the filing date that these claims should be accorded, the examiner has concluded that the earliest date the currently pending claims are entitled to is 8/2/1994. The instant examiner has reviewed the originally filed specification of 07/994,182 (which was an File Wrapper Continuation of 07/678,863) along with the instant specification (08/720927) and does not feel that there is sufficient support for the claimed subject matter to allow the instant pending claims to get the benefit of a 4/1/1991 filing date. The examiner also notes that applicant has previously filed a communication under 37 CFR 1.607(c) in a possible attempt to invoke an interference with a US Patent to Ramsden (US 5481464). 37 CFR 1.607(c) has been deleted from Title 37 and new 37 CFR 41.202 appears to be the appropriate authority for suggesting an interference. The examiner also notes that to provoke/suggest an interference, the applicant has the responsibility to set forth where support for the claimed subject matter can be found in the specification. The examiner does not see any papers where this has been done. In this case because applicant is apparently attempting to suggest an interference with a US Patent to Ramsden, and because any possible interference can only go forward if applicant obtains a filing date for the claims that predates the dates given to the claims of Ramsden, the examiner requests a showing of where support comes from in the 07 series applications for what is being

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claimed. The examiner also submits to applicant that the new 37 CFR 41.202 should be complied with if any interference is desired by applicant.

The examiner does not feel that the claims are entitled to the 4/1/1991 filing date. With respect to the claims, applicant is using means plus function language to define various elements (i.e. means for inputting information relating to the destination of the item). With respect to the means for inputting information limitation, this is found in all of the independent claims. The instant specification sets forth that the means for inputting information can be a touch screen, a keyboard, or even a voice activated system such as a digitized voice recognition system. The specification from 07/678,863 disclosed a touch screen or a conventional computer keyboard as being the input mechanism but the word "means" was never used. The instant specification is setting forth guidance to the examiner that the means plus function language is to be given a different scope than that originally disclosed in the 07 cases, because now there is the embodiment of the voice recognition system that is included in the current means plus function language. Because 112,6th paragraph instructs the examiner to consult the specification as to the scope of the means plus function language, it is found that the scope is different. The scope of the means for inputting limitation has been set forth in the instant specification to be different than the disclosed touch screen and keyboard from 07/678,863. Because of this reason the examiner does not feel that this limitation goes back to 1991, because it includes the voice recognition embodiment that was first disclosed on 8/2/1994. The examiner needs to clearly understand what the scope of the means language is (what it includes) to properly assess the correct filing date for the

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claims. If the means for inputting includes the voice recognition embodiment, then the 1994 date seems correct, whereas if the means for inputting does not include the voice recognition embodiment, the limitation may be accorded a 1991 date. Clarification from applicant on the scope of this language is requested to make it clear exactly what is being claimed. The language in the claims about there being "means for communicating" the charges information to a central location for billing (or to a credit card service center, or to the account of the person owning the credit card, etc.) does not appear to have support in the 07 series cases. In the 07 series specification it was stated on page 1 that *"Alternatively, the customer may use a credit card to make payment."* but this language does not necessarily mean that the credit card payment was actually done by using the automated package/letter shipment system. The examiner cannot find any teaching that goes back to 1991 that states the machine is actually using the credit card. It is possible that the credit card transaction would be conducted by seeing a cashier at the location where the machine is stored. The examiner does not take the one sentence from page 1 of the specification of 07/678,863 to be a disclosure that the package machine itself actually takes the credit card and processes the transaction. Additionally, the language in the claims is reciting the communication of credit card information through phone lines and this was never disclosed in 07/678,863. While it is possible to conduct a credit card transaction by using phone lines linked to credit card companies, it is also known that credit card transactions are conducted by a manual taking of a carbon copy of the credit card and the business owner then submits the receipt for later compensation. The statement that

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"Alternatively, the customer may use a credit card to make payment." does not necessarily mean or support the recitation that the credit card data is being communicated by phone lines to a central location or credit card service center (see claim 3). The examiner requests clarification and a showing of where support comes from for this limitation in the 07 series cases. With respect to the recitation of *"means for storing the inputted information once said item is disposed in said secured storage means"* as is recited in claim 5, the examiner does not feel that this limitation has support in the 07 series cases. This is because on page 2 of 07/678,863 it is stated *"When a machine operator (e.g. a convenience store clerk) inputs an appropriate instruction at the "end of the day", a hard copy manifest of packages received by the machine is generated"*. This language makes no mention at all of when the information is allegedly being stored but the examiner notes that the claim language states *"means for storing the inputted information once said item is disposed in said secured storage means"*. The recitation of when the storage is happening does not find support in the 07 series cases. There is inherently going to be additional structure in the way of computer coding and hardware that would instruct the storage of data to occur once it is detected that the package is in the secured storage means and this does not find support back to 4/1/1991. With respect to claim 7, the examiner cannot find any support back to 1991 for a means for communication the stored information to a remote location because the 07 series case only discloses that a hard copy manifest of packages received by the machine is generated. Where does support come from in the 07 series case for the communication of this information to a remote location? The examiner cannot find any.

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For claims 9 and 11, 07/678,863 made no mention of a “*means for validating*” the credit card “*prior to issuing the shipping label.*” Where was it disclosed that the credit card is validated before issuing the shipping label? As stated previously the only mention of using a credit card occurred at page 1 of the 07 series cases, and this sentence makes no mention of what has been claimed in claim 9. Where does support come from back to 1991? In claim 10, what about the “means for transmitting a manifest to a remote location”? Where does support come from for this limitation in the 07 series cases?

The pending claims have only been accorded the date of 8/2/1994 because the examiner does not believe that the 07 series cases provide support for what is claimed.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-19, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1, at line 9, there is no antecedent basis for “said communication means” and it is not clear as to what is this referring to. This limitation is also found in claims 13 and 14. This Applicant has claimed “*means in communication with said control means, for accepting identification information relating to eventual payment from the customer*” but this is not reciting a communication means. This is reciting a *means for accepting identification information*. What is the claimed “communication means”? With respect to the recited “*charges information*” what does this refer to? The examiner

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does not see where any "charges information" have been claimed. There is a shipment fee recited at line 6 but it is not clear as to what the charges information is/are. Are they the same as the shipment fee or is this another type of fee that is just being called a charge to distinguish from the shipment fee? The examiner also finds the last paragraph to be indefinite. This is because applicant is reciting a secure deposit means that permits the customer to securely deposit the item into the storage area. This language is defining the storage area and the secure deposit means as different elements, but then applicant recites a first zone that serves as a holding space when the item is placed in the storage area. This language seems to be reciting that the first zone (that serves as a holding space) is actually the same as the storage area. This is not proper because they are claimed as different elements but also seem to be claimed as being the same elements. It is not clear as to what the secure deposit means is because it seems to include the storage area that is recited as another distinct element in the claim. This renders the claim indefinite.

For claims 3,15, with respect to the recitation of "said means for communicating", it is not clear as to what this is. Is this the "said communication means" of claim 1 that is also recited as "comprising means for receiving and reading a credit card" or is this the recited "means for communicating the charges information" of claim 1? This is not clear because of the fact that it was previously recited that the communication means comprises means for receiving and reading a credit card, and claim 3 is reciting the means for communicating (that was recited in claim 1 as communicating the charges information) as comprising a card reader (which seems to be what the communication

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means was recited as comprising). Another issue with this language is the fact that a reading of the claim scope reveals that the claim includes both a “means for receiving and reading a card” (which is a card reader in the specification) and as including a “card reader”, for a total of two elements that read the card. The scope of this claim is not clear and is considered to be indefinite.

For claim 4, the recitation of “said means outer housing” is indefinite. What does this refer to? An outer housing is claimed in claim 1 but there is no means language associated with the outer housing in claim 1 so what is the means being recited in claim 4? Should this just be recited as “outer housing”?

For claims 5,10,19, with respect to the language “said means for communicating the shipment fee being by telephone lines”, is this a positive recitation that the means for communicating the shipment fee is a telephone line? It is not clear as to what “*being by telephone lines*” actually means. The scope is unclear.

For claim 6, there is no antecedent basis for “said manifest”. Is a manifest part of the scope of claim 5 as the language “said manifest” implies? The examiner does not see where one has been claimed in claim 5. Should this language be changed to “for printing a hard copy of a manifest”?

For claims 9,11, what is the “means for validating said credit card prior to issuing the shipping label” or the “means for validating said account prior to issuing the shipping label”? is the means for validating the telephone lines that allow a credit check to occur, or is the means for validating the credit card service center that may be contacted if the transaction is to occur electronically? What exactly is the means for validating?

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For claims 12,16, the language “said account charge” has no antecedent basis and it is not clear if this is actually the same thing as the shipment fee of claim 10, or if this is another charge in addition to the shipment fee, for a total of two, one fee and one charge. What is “said account charge”?

For claims 13,14, there is no antecedent basis for “the charges information” and “the charges”. How is the charges information different from the charges? Also, are these the same or different from the shipment fee? It is not clear as to what these limitations are referring to.

For claims 13,14, the examiner also finds the last paragraph to be indefinite. This is because applicant is reciting a secure deposit means that permits the customer to securely deposit the item into the storage area. This language is defining the storage area and the secure deposit means as different elements, but then applicant recites a first zone that serves as a holding space when the item is placed in the storage area. This language seems to be reciting that the first zone (that serves as a holding space) is actually the same as the storage area. This is not proper because they are claimed as different elements but also seem to be claimed as being the same elements. It is not clear as to what the secure deposit means is because it seems to include the storage area that is recited as another distinct element in the claim. This renders the claim indefinite.

For claim 14, applicant is claiming a system. Applicant then recites “said weighing means supported by said system”. This makes no sense because the weighing means is a part of the system so how can it be recited that a part of the

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system is supported by the system? Is the weighing means actually a part of the system or is this claim directed to a combination of a system and a weighing means, where the weighing means is not part of the system? This is not clear.

For claims 16,19, the language "to the account of the person" has no antecedent basis because no account has previously been claimed and no person has been claimed. Also, with respect to the language "said means assessing comprising means for printing", what is the "said means assessing" referring to? Is this supposed to be written as "said means for communicating and assessing the shipment fee" or is the "means assessing" another means altogether? For the language "said account charge", there is no antecedent basis for this term. What does this refer to, the shipment fee or another charge in addition to the shipment fee?

For claim 17, how is the recited "means for communicating" different from the "means for communicating and assessing" that is recited in claim 16? If they are not the same thing then it is not clear as to what structure from the specification is covered by the means language of claim 17. For the language "said account charge", there is no antecedent basis for this term. What does this refer to, the shipment fee or another charge in addition to the shipment fee?

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ramsden (5481464). Ramsden discloses the claimed invention.

5. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Under 37 CFR 1.105(a)(1)(viii), the examiner is requesting information concerning the disclosed invention, the claimed subject matter, and this is concerning the accuracy of the examiner's interpretation of these issues. This information is pertinent to the patentability of the claims because the issue of what filing date the claims are to be given is of vital importance to the prosecution of this application.

The examiner requests a detailed explanation that addresses the scope of each and every limitation found in the claims (i.e. what does the "means" language cover as far as structure goes). Applicant is using means plus function language to define the invention and the examiner must know what the scope of these terms are, so that it can be determined whether or not there is proper support in 07/768,863 for the scope of each claim limitation. The corresponding structure/acts from the specification that the means plus function language covers is requested in the explanation from applicant. The instant application is a CIP of 07/768,863 and the fact that there are substantial

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subject matter additions in the specification with respect to various embodiments that relate to the means plus function language necessitates this request.

The examiner is requesting that applicant provide a detailed explanation of where support can be found in 07/768,863 for the each and every of the claimed limitations and the scope that these limitations have. This is needed so the examiner can conclusively ascertain the correct filing date for each of the pending claims and for the claimed limitations.

6. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

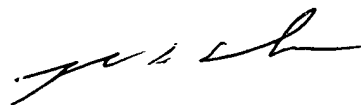
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER



JOHN G. WEISS
SENIOR PATENT EXAMINER
TECHNICAL CENTER 3900